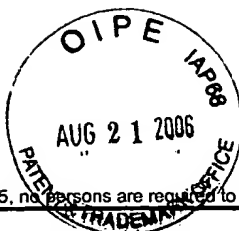


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

02908.000005.

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name _____

Application Number

09/853,767

Filed

May 14, 2001

First Named Inventor

Sebastien Jean, et al.

Art Unit

2152

Examiner

Philip C. Lee

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 32,622

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Michael K. O'Neill

Typed or printed name

(714) 540-8700

Telephone number

August 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 4 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT APPLICATION

02908.000005.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

SEBASTIEN JEAN, et al.

Application No.: 09/853,767

Filed: May 14, 2001

For: NETWORK DEVICE MIMIC
SUPPORT

Examiner: Philip C. Lee

Group Art Unit: 2154

August 18, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection based on the following remarks.

I. Status of the Claims

Claims 1 to 40 are pending, of which Claims 1 and 33 are the only independent claims. Independent Claim 1 stands rejected under 35 U.S.C. § 103(a) over U.S. Application Publication No. 2002/0080391 (Sugiura) in view of U.S. Patent No. 6,816,270 (Cooper), and independent Claim 33 stands rejected under § 103(a) over Sugiura and Cooper in view of U.S. Patent No. 6,611,863 (Banginwar). The other claims are dependent and stand rejected as above or further in view of one or more of the following: U.S. Patent No. 6,240,456 (Teng), U.S. Patent No. 6,757,280 (Wilson), U.S. Patent No. 6,157,950 (Krishnan), U.S. Patent No. 6,020,973 (Levine), and U.S. Patent No. 6,742,039 (Remer).

II. The Claimed Invention

Applicants' invention is directed to a method for mimicking network devices, wherein the method is performed in a computing device having first and second network interface cards. In one representative embodiment described in the specification, the network device is a network printer which might be a legacy printer that does not contain a full repertoire of modern printer functionality. The network printer resides on a local network to which the computing device connects via the second network interface card. The computing device connects to an external network via the first network card.

In operation, the computing device receives a message addressed to the network address of the network printer, and determines whether an application module in the computing device can process a functionality requested by the message, such as secure printing, that the printer might not support. In this way, the same set of functional capabilities can be made available to all network users from a group of network devices having different functional capabilities, often avoiding costly upgrades of legacy devices.

All claims are method claims. According to the claim language, a first network card connects the computing device to an external network, and a second network card connects the computing device to a local network. An incoming message is received from a client network device residing on the external network, and the incoming message is addressed to a network address of a target network device residing on the local network. A determination is made as to whether an application module residing in the computing device is configured to process a functionality requested by the incoming message. In the case that the application module is configured to process the functionality, the incoming message is redirected to the application module. In the case that the application module is not configured to process the functionality, the incoming message is passed through the local network to the target network device residing on the local network.

III. Clear Errors in the Examiner's Rejection

There are at least four claimed features that are not met by the Examiner's rejection, such that the factual predicates for a prima facie rejection have not been met: a) an incoming message that is addressed to a "network address" of a target network device,

b) a determination of whether an application module residing in the computing device is configured to process a functionality requested by the incoming message, c) redirection of an incoming message to an application module residing in the computing device in the case that the application module is configured to process the functionality, and d) passing of the incoming message through the local network to the target network device in the case that the application module is not configured to process the functionality.

A. Claimed Feature: “receiving an incoming message from a client network device residing on the external network, the incoming message being addressed to a network address of a target network device residing on the local network”

In the Advisory Action dated June 27, 2006, the Examiner explains his rejection as follows: “since [Sugiura’s] HTTP data DT contains the address of the target printer in the header of the HTTP data DT, certainly the HTTP data DT can be consider as being addressed to a target device.” (Advisory Action, page 2). This ignores the clear language of the claims, which specifies that the message is addressed to the “network address” of the target device. Put another way, the claim language does not simply require a message that is “addressed to a target device”, as incorrectly stated by the Examiner; rather, the claim language requires a message that is addressed to the “network address” of the target device. Applicants have repeatedly explained that a message *containing* an address of a target, as in Sugiura, is not the same as the message itself being *addressed* to a target, as in the present invention (see, e.g., pages 15 to 17, Response filed May 31, 2006), but the Examiner’s rejection does not address this issue. Sugiura’s HTTP data is addressed to a print server, not to a target printer; it is the print server which then routes data to a target printer. The Examiner’s rejection is akin to saying that an envelope addressed to person A, containing a letter with person B’s address, is actually addressed to person B. This interpretation is incorrect and conflates two distinct functionalities. Thus, the Examiner’s rejection has not met the claim language of this feature.

B. Claimed Feature: “determining if an application module residing in the computing device is configured to process a functionality requested by the incoming message”

In the same Advisory Action, the Examiner contends that Cooper “teaches receiving a print job, determining if support for the request functionality is in a printer, if support is not present, software simulation (application module) is configure [sic, configured] to process the requested functionality.” (Advisory Action, page 2). Even assuming that this statement is correct, it is irrelevant since it ignores the clear language of Applicants’ claims. Cooper’s alleged determination of whether a *target printer* can support a requested functionality is irrelevant, as the claim language requires a determination of whether an application module *in the computing device* is configured to process the functionality. (See also page 18, Response filed May 31, 2006).

The Advisory Action also reasons that Cooper’s “process sends the print job (passing the message) to the printer if the support for the requested functionality is in the printer. This means software simulation (application module) is not configure [sic, configured] to process the functionality requested.” (Advisory Action, page 3). Clearly this reasoning is logically and technologically flawed. It cannot seriously be argued that sending a print job to a printer if support for requested functionality is in the printer might somehow involve a determination of the capabilities of Cooper’s software simulation. No such logical link exists, nor has any reasoning for such a link been presented. More generally, the Examiner has never taken the position that Cooper discloses a determination of whether a requested functionality can be processed by its software simulation, and in fact Cooper never even contemplates that its software simulation might be *incapable* of processing a functionality.

Thus, the Examiner’s rejection has also not met the claim language of this feature.

C. Claimed Feature: “redirecting the incoming message to the application module in the case that the application module is configured to process the functionality”

-and-

D. Claimed Feature: “passing the incoming message through the local network to the target network device residing on the local network in the case that the application module is not configured to process the functionality”

As noted above, the Examiner fails to address the claim language requiring a determination of whether an application module in the computing device (Cooper's software simulation) is configured (or is not configured) to process a functionality, and rather addresses whether a *printer* can perform a service. Thus, the Examiner's rejection has not met the claimed "case" statements at all.

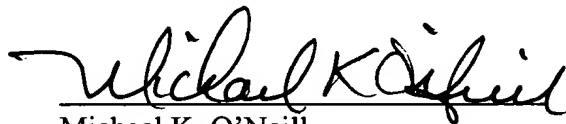
This failure to meet claim language is underscored in the Advisory Action: "...if support is not present [in Cooper's printer]...the process must redirected [sic, redirect] the print job to the software (application module) that performs the simulation." (Advisory Action, page 2). This fails to address the claimed circumstances of when redirection occurs. Redirection occurs based on the configuration of an application module (not based on the configuration of a printer as asserted in the rejection), and it occurs in a case where the application module *is* configured to process functionality.

Since the rejection fails to address the claimed circumstances for a redirection, it naturally follows that it also fails to address the claimed circumstances for the claimed "passing".

IV. Conclusion

In view of the foregoing, it is respectfully requested that the rejections of record be withdrawn and the case passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael K. O'Neill", written over a horizontal line.

Michael K. O'Neill
Attorney for Applicants
Registration No.: 32,622

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

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